

REMARKS

Claim Rejections

Claims 1-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Arakawa et al. (U.S. 2003/0164243) in view of Yoshida et al. (U.S. 6, 621,003).

Drawings

It is noted that no Patent Drawing Review (Form PTO-948) was received with the outstanding Office Action. Thus, Applicant must assume that the drawings are acceptable as filed.

New Claims

By this Amendment, Applicant has canceled claims 1-13 and has added new claims 14-25 to this application. It is believed that the new claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

New claims 14-19 are directed toward an electromagnetic wave shielding structure comprising: a transparent substrate (210) having a top substrate face and a bottom substrate face; a mesh (220) having a top mesh face and a bottom mesh face connected to the top substrate face; and a first layer of pressure sensitive adhesive (230) having a top adhesive face and a bottom adhesive face connected to the top mesh face, the first layer of pressure sensitive adhesive being a predetermined thickness.

Other embodiments of the present invention include: a first mold-releasing film (310) connected to the top adhesive face; a second mold-releasing film (330) connected to the bottom substrate face; a second layer of pressure sensitive adhesive (320) located between the second mold-releasing film and the bottom substrate face; the transparent substrate is a layer of polyethylene terephthalate; and the transparent substrate is a layer of triacetate.

New claims 20-25 are directed toward method for manufacturing an electromagnetic wave shielding structure, which comprises the steps of: pasting a

bottom face of a mesh to a top face of the transparent substrate; and coating a first layer of pressure sensitive adhesive on a top face of the mesh, the mesh is located between the transparent substrate and the first layer of pressure sensitive adhesive.

Other embodiments of the present invention include: the step of pasting a first mold-releasing film on a top face of the first layer of pressure sensitive adhesive, the first layer of pressure sensitive adhesive is located between the first mold-releasing film and the mesh; the step of pasting a second mold-releasing film on a bottom of the transparent substrate, the transparent substrate is located between the second mold-releasing film and the mesh; the steps of coating a second layer of pressure sensitive adhesive on a bottom of the transparent substrate, and pasting a second mold-releasing film on a bottom of the second layer of pressure sensitive adhesive, the second layer of pressure sensitive adhesive and the transparent substrate are located between the second mold-releasing film and the bottom substrate face; the transparent substrate is a layer of polyethylene terephthalate; and the transparent substrate is a layer of triacetate.

The primary reference to Arakawa et al. teaches an electromagnetic shielding sheet including a net-like metallic foil (11'), an adhesive layer (13), and a transparent substrate film (14). The adhesive layer being located between the net-like metallic foil and the transparent substrate film.

Arakawa et al. do not teach a mesh having a bottom mesh face connected to the top substrate face; a first layer of pressure sensitive adhesive having a bottom adhesive face connected to the top mesh face; a first mold-releasing film connected to the top adhesive face; a second mold-releasing film connected to the bottom substrate face; nor do Arakawa et al. teach a second layer of pressure sensitive adhesive located between the second mold-releasing film and the bottom substrate face.

The secondary reference to Yoshida et al. teaches an electromagnetic shielding material including a transparent base material (1), a mesh-like conductive material (3), a hot melt adhesive resin layer (2) covering the mesh-like conductive material, and a polymer function film (4) located on a top of the hot melt adhesive resin layer. Additionally, a pressure sensitive adhesive can be located between the polymer function film and the hot melt adhesive resin layer.

Yoshida et al. do not teach a first layer of pressure sensitive adhesive having a bottom adhesive face connected to the top mesh face; a first mold-releasing film connected to the top adhesive face; a second mold-releasing film connected to the bottom substrate face; nor do Yoshida et al. teach a second layer of pressure sensitive adhesive located between the second mold-releasing film and the bottom substrate face.

Even if the teachings of Arakawa et al. and Yoshida et al. were combined, as suggested by the Examiner, the resultant combination does not suggest: a first layer of pressure sensitive adhesive having a bottom adhesive face connected to the top mesh face; a first mold-releasing film connected to the top adhesive face; a second mold-releasing film connected to the bottom substrate face; nor does the combination suggest a second layer of pressure sensitive adhesive located between the second mold-releasing film and the bottom substrate face.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Arakawa et al. or Yoshida et al. that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

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Neither Arakawa et al. nor Yoshida et al. disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's new claims.

Summary

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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